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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/542,142

08/12/2005

Stephen George Edward Barker

117-553 (AMK)

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03/01/2011

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ARLINGTON, VA 22203

EXAMINER

OU, JING RUI

ART UNIT

PAPER NUMBER

3773

MAIL DATE

DELIVERY MODE

03/01/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/542,142 | Applicant(s) BARKER, STEPHEN GEORGE EDWARD | |
| | Examiner JING RUI OU | Art Unit 3773 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 17, 20-25 and 27-35 is/are pending in the application.
- 4a) Of the above claim(s) 17, 20-22, 24, 29, 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 23, 25, 27, 28, 30, 33, and 35 is/are rejected.
- 7) ☒ Claim(s) 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive the amendment and the RCE filed on 11/17/2010. Claims 13, 17, 20-25, and 27-335 are pending. Claim 27 is independent. Claims 1-12, 14-16, 18, 19, and 26 are cancelled. Claims 17, 20-22, 24, 29, 31, and 32 are withdrawn from consideration. Claims 34 and 35 are newly added.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/17/2010 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 13, 23, 25, 27, 28, 30, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solecki et al (WO 01/97713) in view of Amara et al (US Pub. No.: 2002/0116070).

In regard to Claims 13, 25, 27, 28, 30, 33, and 35, Solecki et al discloses an implantable prosthesis, comprising a flexible plug (combinations of 1, 2, and 3) of surgically compatible mesh material, the plug have an elongate form and comprising an external mesh material wall (1); wherein the external material wall has three outwardly projecting longitudinal ridges or bulges (the ridges or bulges of 1), the internal support being sufficient ridge to maintain the size and shape of the external mesh material wall (See Abstract and Fig. 2, the internal support is capable to sufficient ridge to maintain the size and shape of the external mesh material wall depending on the amount of the external force); and the plug further comprising an internal support webs (combination of 2 and 3) extending into contact with respective interiors of at least outermost portions of the outwardly projecting longitudinal ridges or bulges (Fig. 2); wherein the webs are formed by separate parts bonded to an inner surface of the external mesh material wall (see Abstract); wherein the mesh material includes at least one joint (Fig. 2, the mesh material has at least one joint between each ridges or bulges); and wherein the mesh material comprises polypropylene (page 6, lines 28-35).

Solecki et al does not appear to disclose that the plug has a prismatic shape and a closed generally triangular cross-sectional shape. However, Amara et al discloses a mesh plug can be any different shapes or structure suitable for conforming to specific

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tissue defect anomaly (Paras. [0014] and [0045]). Applicant should be noted that the shape or cross-sectional shape of the plug is merely an obvious design choice and within one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the to modify plug of Solecki et al to obtain shape or structure such as prismatic shape suitable for conforming to specific tissue defect anomaly as taught by Amara et al

In regard to Claim 23, the claimed phrase “wherein the plug is cut to an appropriate required dimension from a stock length piece” is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. MPEP 2113.

Allowable Subject Matter

6. Claim 34 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments with respect to claims 13, 23, 25, 27, 28, 30, 33, and 35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JING OU whose telephone number is (571)270-5036. The examiner can normally be reached on M-F 7:30am - 5:00pm, Alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Uyen (Jackie) T Ho can be reached on (571)272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. O./
Examiner, Art Unit 3773
02/19/2011

/(Jackie) Tan-Uyen T. Ho/

Supervisory Patent Examiner, Art Unit 3773

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